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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 10/762,427   | 01/22/2004  | Jonathan Feinberg    | 260-007<br>LOT9-2003-0108US1 | 4906             |
| 44185  | 7590        | 01/23/2007           | EXAMINER                     |                  |
| LOTUS AND RATIONAL SOFTWARE<br>McGuinness & Manaras LLP<br>125 NAGOG PARK<br>ACTON, MA 01720 |             |                      | ALI, OMAR R                  |                  |
|  |             |                      | ART UNIT                     | PAPER NUMBER     |
|  |             |                      | 2109                         |                  |
| SHORTENED STATUTORY PERIOD OF RESPONSE   |             | MAIL DATE            | DELIVERY MODE                |                  |
| 3 MONTHS   |             | 01/23/2007           | PAPER                        |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/762,427             | FEINBERG ET AL.     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Omar Abdul-Ali         | 2112                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 January 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-32 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 January 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>08/2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____.                         |

## DETAILED ACTION

This action is in response to the original filing of January 22, 2004. Claims 1-32 are pending and have been considered below.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 32 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A carrier wave is a form of energy, and does not fall within one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 13 recites the limitation "said activity level". There is insufficient antecedent basis for this limitation in the claim. The Examiner takes note that the activity level was previously mentioned in Claim 12, and thus will further examine Claim 13 as being dependent from Claim 12.

Art Unit: 2112

4. Claim 23 recites the limitation "said activity level". There is insufficient antecedent basis for this limitation in the claim. The Examiner takes note that the activity level was previously mentioned in Claim 22, and thus will further examine Claim 23 as being dependent from Claim 22.

5. Examiner's Note. The Applicant appears to be attempting to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph in Claims 11-13 and 18-20, by using "means-plus-function" language. However, the Examiner notes that the only "means" for performing these cited functions in the specification appears to be computer program modules. While the claims pass the first test of the three-prong test used to determine invocation of paragraph 6, since no other specific structural limitations are disclosed in the specification, the claims do not meet the other tests of the three-prong test. Therefore, 35 U.S.C. 112 6<sup>th</sup> paragraph has not been invoked when considering these claims below.

### ***Drawings***

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "58" and "71" have both been used to designate the dynamically linked library in the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be

labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "180" and "182" have both been used to designate a display. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

8. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "302" has been used to designate both a basic activity sharing check box and a history of document accesses sharing checkbox in the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement

drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

9. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 561. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 8-13, 18-23, 28-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Godefroid et al. (US 6,697,840).

Claims 1, 11, 21, 31, and 32: Godefroid discloses a method and apparatus implementing presence awareness in collaborative systems comprising:

- a. sensing the number of instant messaging sessions associated with a user of a remote computer system (column 5, lines 19-46);
- b. conveying said number of instant messaging sessions from remote user to awareness server (column 5, lines 19-46);
- c. conveying said number of instant messaging sessions from remote user to awareness server (column 5, lines 19-46);

d. presenting, by awareness client application process, said number of instant messaging sessions in a display for said local computer system (column 5, lines 19-46).

Claims 2, 12, 22: Godefroid discloses a method and apparatus implementing presence awareness in collaborative systems as in Claims 1, 11, and 21 above, further comprising:

- a. sensing activity level associated with at least one of said instant messaging sessions associated with said user of said remote computer system (column 5, lines 19-46);
- b. conveying said activity level from remote computer system to awareness server application process (column 5, lines 19-46);
- c. presenting, by awareness application process, activity level associated with user of remote computer system in said display for said local computer system (column 5, lines 19-46).

Claims 3, 13, and 23: Godefroid discloses a method and apparatus implementing presence awareness in collaborative systems as in Claims 2, 12, and 22 above, further comprising:

- a. presenting said number of instant messaging sessions and activity level simultaneously in said display for said local computer system (column 5, lines 19-46).

Claims 8, 18, and 28: Godefroid discloses a method and apparatus implementing presence awareness in collaborative systems as in Claims 1, 11, and 21 above, further comprising:

- a. presenting modal dialog box in response to detection of a request by user of local computer system for instant message system with user of remote system, includes indication of whether or not to terminate said request (column 5, lines 52-55).

Claims 9, 19, and 29: Godefroid discloses a method and apparatus implementing presence awareness in collaborative systems as in Claims 1, 11, and 21 above, further comprising:

- a. presenting an interface to said local user that indicates whether a number of instant messaging associated with said user of said local computer system is to be shared with other users (column 6, lines 12-18).

Claims 10, 20, and 30: Godefroid discloses a method and apparatus implementing presence awareness in collaborative systems as in Claims 1, 11, and 21 above, further comprising:

- a. presenting an interface that enables said user of said local computer system to specify one or more other users with which a number of instant messaging sessions associated with local user is to be shared (column 6, lines 12-18).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4-7, 14-17, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Godefroid et al. (US 6,697,840).

Claims 4, 14, and 24: Godefroid discloses a method and apparatus implementing presence awareness in collaborative systems as in Claims 3, 13, and 22 above, but does not explicitly disclose that the activity level reflects a time at which the most recent keystroke was entered by said user of said remote computer system. However, Godefroid does disclose that the start time and end time of a collaboration session is available to users (column 7, lines 52-54). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that a time stamp could be applied to any message sent by a user. One would have been motivated to determine the time the most recent keystroke was entered for record keeping purposes, and to keep track of a user's presence on their computer terminal.

Claims 5, 15, and 25: Godefroid discloses a method and apparatus implementing presence awareness in collaborative systems as in Claims 4, 14, and 24 above, but

Art Unit: 2112

does not explicitly disclose that the activity level reflects a time at which a most recent text message was received by said user of said remote computer system. However, Godefroid does disclose that the start time and end time of a collaboration session is available to users (column 7, lines 52-54). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that a time stamp could be applied to any message received from a remote user. One would have been motivated to determine the time at which a most recent text message was received by a remote user for record keeping purposes.

Claims 6, 16, and 26: Godefroid discloses a method and apparatus implementing presence awareness in collaborative systems as in Claims 5, 15, and 25 above, further comprising:

- a. activity level indicating time at which instant messaging session was initiated (column 7, lines 52-54).

Claims 7, 17, and 27: Godefroid discloses a method and apparatus implementing presence awareness in collaborative systems as in Claims 5, 13, and 24 above, further comprising:

- a. sensing identity of at least one other participant in an instant messaging session with said user of said remote computer system (column 5, lines 19-46);
- b. conveying said identity from said remote computer system to said awareness server application process (column 5, lines 19-46);

Art Unit: 2112

c. presenting said identity of at least one other participant in said display for said local computer system (column 5, lines 19-46).

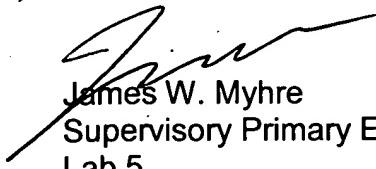
***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar Abdul-Ali whose telephone number is 571-270-1694. The examiner can normally be reached on Mon-Fri(Alternate Fridays Off) 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 571-270-1065. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OAA  
01/09/2007



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